A 87283

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants:	**Daniel Scheidewend, et al.**
Serial Number:	**09/445,268**
Atty. Docket:	**RCA 89,068**
Filing Date:	**April 3, 2000**
For:	**SYSTEM AND METHOD FOR COORDINATING USER ACTIONS**
Art Unit:	**2623**
Examiner:	**Michael Van Handel**

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the Advisory Action dated December 18, 2006, and further to the Notice of Appeal filed on January 19, 2007, Appellants hereby submit an Appeal Brief in accordance with 37 C.F.R. §41.37 for the above-referenced application.

I. Real Party in Interest

The real party in interest is Thomson Licensing LLC.

II. Related Appeals and Interferences

There are no prior or pending appeals, interferences, or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 16-25 are pending in this application, and are rejected. The rejection of claims 16-25 is being appealed.

IV. Status of Amendments

No amendment subsequent to the final rejection of September 21, 2006 has been filed.

V. Summary of Claimed Subject Matter

Independent claim 16 defines a method for processing a plurality of programs, comprising: receiving a first user input selecting a first program for removal from a first list representing a list of programs scheduled for recording (page 29, lines 17-21; FIGS. 7 and 11); receiving a second user input selecting a second program for removal from a second list representing a list of programs purchased (page 30, lines 8-19; FIGS. 8 and 12); determining whether the second program also appears on the first list responsive to the second user input (page 30, lines 19-22; FIG. 8); and removing, automatically, the second program from the first list if the second program appears on the first list (page 30, lines 22-24; FIG. 8).

Independent claim 17 defines a method for processing a program, comprising: removing, in response to a user command, the program from a first list of programs representing programs scheduled for recording (page 29, lines 17-21; FIGS. 7 and 11); determining, in response to the user command, whether the program is also a

purchased program (page 29, lines 22-25; FIG. 7); enabling an on screen display including an option to cancel the purchase of the program if it is determined that the program is also a purchased program (page 29, line 25 to page 30, line 1; FIGS. 7 and 12); and removing the program from a second list of programs representing purchased programs responsive to user selection of the option (page 30, lines 1-3; FIG. 7).

Independent claim 18 defines an apparatus for processing a program, comprising: first means (element 312; FIG. 4) for receiving a first user input selecting a first program for removal from a first list representing a list of programs scheduled for recording (page 29, lines 17-21; FIGS. 7 and 11), and for receiving a second user input selecting a second program for removal from a second list representing a list of programs purchased (page 30, lines 8-19; FIGS. 8 and 12); and second means (element 315; FIG. 4) for determining whether the second program also appears on the first list responsive to the second user input (page 30, lines 19-22; FIG. 8), and for automatically removing the second program from the first list if the second program appears on the first list (page 30, lines 22-24; FIG. 8).

Independent claim 20 defines an apparatus for processing a program, comprising: first means (element 312; FIG. 4) for receiving a user command; and second means (element 315; FIG. 4) for removing the program from a first list of programs representing programs scheduled for recording responsive to the user command (page 29, lines 17-21; FIGS. 7 and 11). The second means determines whether the program is also a purchased program responsive to the user command (page 29, lines 22-25; FIG. 7), and enables an on screen display including an option to cancel the purchase of the program if it is determined that the program is also a purchased program (page 29, line 25 to page 30, line 1; FIGS. 7 and 12). The program is removed from a second list of programs representing purchased programs responsive to user selection of the option (page 30, lines 1-3; FIG. 7).

Independent claim 22 defines an apparatus for processing a program, comprising: a receiver (element 312; FIG. 4) operative to receive a first user input selecting a first program for removal from a first list representing a list of programs

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scheduled for recording (page 29, lines 17-21; FIGS. 7 and 11), and to receive a second user input selecting a second program for removal from a second list representing a list of programs purchased (page 30, lines 8-19; FIGS. 8 and 12); and a processor (element 315; FIG. 4) operative to determine whether the second program also appears on the first list responsive to the second user input (page 30, lines 19-22; FIG. 8), and to automatically remove the second program from the first list if the second program appears on the first list (page 30, lines 22-24; FIG. 8).

Independent claim 24 defines an apparatus for processing a program, comprising: a receiver (element 312; FIG. 4) operative to receive a user command; and a processor (element 315; FIG. 4) operative to remove the program from a first list of programs representing programs scheduled for recording responsive to the user command (page 29, lines 17-21; FIGS. 7 and 11). The processor is further operative to determine whether the program is also a purchased program responsive to the user command (page 29, lines 22-25; FIG. 7), and to enable an on screen display including an option to cancel the purchase of the program if it is determined that the program is also a purchased program (page 29, line 25 to page 30, line 1; FIGS. 7 and 12). The program is removed from a second list of programs representing purchased programs responsive to user selection of the option (page 30, lines 1-3; FIG. 7).

VI. Ground of Rejection to be Reviewed on Appeal

The following grounds of rejection are presented for review in this appeal:

1.   The rejection of claims 16-18, 20, 22 and 24 under 35 U.S.C. §103(a) based on U.S. Patent No. 5,850,218 issued to LaJoie et al. (hereinafter, "LaJoie"); and

2.   The rejection of claims 19, 21, 23 and 25 under 35 U.S.C. §103(a) based on LaJoie in view of the RCA DRD202RA Owner's Manual (hereinafter, "the RCA manual").

VII. Argument

A. Patentability of Claims 16-18, 20, 22 and 24

The rejection of claims 16-18, 20, 22 and 24 under 35 U.S.C. §103(a) based on LaJoie should be reversed for at least the following reasons.

With respect to independent claims 16, 18 and 22, these claims include:

> "receiving a first user input selecting a first program for removal from a first list representing a list of programs scheduled for recording;
> receiving a second user input selecting a second program for removal from a second list representing a list of programs purchased;
> determining whether said second program also appears on said first list responsive to said second user input; and
> removing, automatically, said second program from said first list if said second program appears on said first list." (see claim 16),

> "first means for receiving a first user input selecting a first program for removal from a first list representing a list of programs scheduled for recording, and for receiving a second user input selecting a second program for removal from a second list representing a list of programs purchased; and
> second means for determining whether said second program also appears on said first list responsive to said second user input, and for automatically removing said second program from said first list if said second program appears on said first list" (see claim 18), and

> "a receiver operative to receive a first user input selecting a first program for removal from a first list representing a list of programs scheduled for recording, and to receive a second user input selecting a second program for removal from a second list representing a list of programs purchased; and
> a processor operative to determine whether said second program also appears on said first list responsive to said second user input, and to automatically remove said second program from said first list if said second program appears on said first list." (see claim 22)

As indicated above, independent claims 16, 18 and 22 define a method/apparatus in which a program (i.e., the "second program") is automatically removed from a list of programs scheduled for recording (i.e., the "first list") in response

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to user removal of the program from a list of programs selected for purchase (i.e., the "second list"). Appellants maintain that LaJoie fails to render the foregoing subject matter of independent claims 16, 18 and 22 obvious under 35 U.S.C. §103(a).

On page 10 of the final Office Action dated September 21, 2006, the Examiner admits that:

> "LaJoie et al. does not specifically disclose determining whether said second program also appears on said first list responsive to said second user input and removing, automatically, said second program from said first list if said second program appears on said first list"

and further states:

> "however, the examiner notes that if a program scheduled for purchasing and recording is canceled from the all timers list, it would be counterintuitive to list it with the VCR timers and PPV purchases in the general settings menu. LaJoie et al. specifically states that selecting the all timers setting causes the display of all active timers in the set-top terminal (col. 22, l. 47-56 & Fig. 14). Thus, in canceling a timer from the all timers setting, the program can no longer be scheduled for purchasing or recording. Removing a program scheduled for purchasing and recording from the all timers list, but not from the list of PPV purchases or VCR timers would cause the PPV purchases and VCR timers lists to present false information to the user. Therefore, it would have been obvious to . . . remove a scheduled event from a list in response to removing the event from a list of all scheduled events, in order to avoid confusing a user."

In response, Appellants note that the Examiner is applying the wrong legal standard for obviousness under 35 U.S.C. §103(a). In particular, the mere fact that a prior art device could (in hindsight) be modified to produce a claimed invention is not a basis for an obviousness rejection unless the prior art suggests the desirability of such a modification. See, for example, *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989) ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to the form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'")

and *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In this case, LaJoie fails to teach or suggest the <u>desirability</u> of the inventions defined by independent claims 16, 18 and 22. In fact, <u>LaJoie fails to even recognize the specific problems that the Appellants have recognized and addressed by the inventions defined by independent claims 16, 18 and 22</u>.

On page 2, lines 13-23 of Appellants' disclosure, they recognize problems associated with the lack of coordination between performing program purchases and program recordings. Page 2, lines 19-23 specifically state:

> ". . . since there is no linkage between these two processes, a user who wants to cancel a program from the purchase process or the record process will have to basically perform the same task twice. This is time consuming and inefficient."

As indicated above, Appellants have recognized the problems associated with a user having to redundantly perform the same task twice by canceling both a program purchase and a program recording. Independent claims 16, 18 and 22 address the foregoing problems by automatically removing a program from a first list of programs scheduled for recording in response to user removal of the program from a second list of programs selected for purchase. As a result, <u>the user is not required to perform the same task twice by removing the program from the first list of programs scheduled for recording</u>. In contrast, <u>LaJoie fails to even recognize</u> the problem associated with a user having to perform the same task twice. As such, LaJoie clearly fails to teach or suggest the <u>desirability</u> of the technique for coordinating program purchases and recordings defined by independent claims 16, 18 and 22, as Federal Circuit law requires for a rejection under 35 U.S.C. §103(a).

Because of LaJoie's <u>complete silence</u> regarding the above-referenced problem, LaJoie's system likely suffers the same deficiencies pointed out above in Appellants' disclosure. That is, a user of LaJoie's system may likely be required to perform the same task twice by removing a program from the list of programs scheduled for recording after he/she removes it from the list of programs selected for purchase. In

any event, LaJoie's failure to teach or suggest the <u>desirability</u> of the inventions defined by independent claims 16, 18 and 22 renders it insufficient as a matter of law to sustain an obviousness rejection under 35 U.S.C.§103(a).

On page 2 of the Advisory Action dated December 18, 2006, the Examiner responds to the foregoing arguments, and again attempts to justify the improper rejection of independent claims 16, 18 and 22 by stating:

> "Regarding the applicant's argument that LaJoie et al. fails to teach or suggest the desirability of the inventions defined by the claims, the examiner respectfully disagrees. <u>The fact that LaJoie et al. discloses an all timers list that causes a list of each active timer in the set-top terminal to be displayed and from which an active timer can be cancelled and removed from the list is representative of a desirability to provide a user with a way to manage timers that is not confusing.</u> Thus, the examiner maintains that it would have been obvious to one of ordinary skill in the art . . . to remove a scheduled event from a list in response to removing the event from a list of all scheduled events in order to avoid confusing a user." (emphasis added)

As indicated above, the Examiner's position is that <u>LaJoie's ability to simply display a list of active timers from which an active timer may be cancelled by a user</u> teaches or suggests the desirability of <u>providing coordination between performing program purchases and program recordings by automatically removing a program (i.e., the "second program") from a list of programs scheduled for recording (i.e., the "first list") in response to user removal of the program from a list of programs selected for purchase (i.e., the "second list"), as defined by independent claims 16, 18 and 22.</u>

In response, Appellants respectfully submit that the Examiner's allegation that LaJoie teaches or suggests the <u>desirability</u> of the inventions defined by independent claims 16, 18 and 22 is severely flawed. In particular, the ability to <u>simply display a list of active timers from which an active timer may be cancelled by a user, as taught by LaJoie,</u> is a completely different function than <u>providing coordination between performing program purchases and program recordings by automatically removing a program (i.e., the "second program") from a list of programs scheduled for recording (i.e., the "first list") in response to user removal of the program from a list of programs</u>

selected for purchase (i.e., the "second list"), as defined by independent claims 16, 18 and 22. As such, the functionality of LaJoie can in no way be considered to teach or suggest the desirability of the functionality defined by independent claims 16, 18 and 22. Accordingly, Appellants respectfully request that the Board reverse the rejection of independent claims 16, 18 and 22.

Next, with respect to independent claims 17, 20 and 24, these claims include:

"removing, in response to a user command, said program from a first list of programs representing programs scheduled for recording;
determining, in response to said user command, whether said program is also a purchased program;
enabling an on screen display including an option to cancel the purchase of said program if it is determined that said program is also a purchased program; and
removing said program from a second list of programs representing purchased programs responsive to user selection of said option." (see claim 17),

"first means for receiving a user command;
second means for removing said program from a first list of programs representing programs scheduled for recording responsive to said user command;
said second means determining whether said program is also a purchased program responsive to said user command, and enabling an on screen display including an option to cancel the purchase of said program if it is determined that said program is also a purchased program; and
wherein said program is removed from a second list of programs representing purchased programs responsive to user selection of said option." (see claim 20), and

"a receiver operative to receive a user command;
a processor operative to remove said program from a first list of programs representing programs scheduled for recording responsive to said user command;
said processor being further operative to determine whether said program is also a purchased program responsive to said user command, and to enable an on screen display including an option to cancel the purchase of said program if it is determined that said program is also a purchased program; and

wherein said program is removed from a second list of programs representing purchased programs responsive to user selection of said option." (see claim 24)

As indicated above, independent claims 17, 20 and 24 define a method/apparatus in which an on screen display option is provided so that a user is afforded an opportunity to cancel the purchase of a program in response to the user canceling a scheduled recording of the program. Appellants maintain that LaJoie fails to render the foregoing subject matter of independent claims 17, 20 and 24 obvious under 35 U.S.C. §103(a).

On pages 10-11 of the final Office Action dated September 21, 2006, the Examiner admits that:

"LaJoie et al. does not specifically disclose determining, in response to said user command, whether said program is also a purchased program; enabling an on screen display including an option to cancel the purchase of said program if it is determined that said program is also a purchased program; and removing said program from a second list of programs representing purchased programs"

and further states:

"however the examiner notes that if a program scheduled for purchasing and recording is canceled from the all timers list, it would be counterintuitive to list it with the VCR timers and PPV purchases in the general settings menu. LaJoie et al. specifically states that selecting the all timers setting causes the display of all active timers in the set-top terminal (col. 22, l. 47-56 & Fig. 14). In canceling a timer from the all timers setting, the program can no longer be scheduled for purchasing or recording and would no longer appear on any timer list. LaJoie et al. also suggests the use of conflicts checking features in verifying that there are no conflicts created by a modified setting (for example, when there are overlapping timers)(col. 21, l. 30-35). LaJoie et al. specifically provides the example of a warning screen that alerts the user when trying to record an IPPV program and provides the user with the option of purchasing the program or canceling the warning (col. 21, l. 42-49). LaJoie et al. further illustrates that programs can be selected for purchasing and viewing or purchasing and recording (indicated by REC and PPV or the timer icon and PPV)(Fig. 14). Since a program scheduled for purchasing and recording could also be scheduled for purchasing and viewing, it would

have been obvious to . . . .use a conflict checking feature to allow a user the options of either purchasing and viewing the program or canceling the program from all timers in order to provide a more user-friendly interface." (emphasis added)

The Examiner makes similar allegations to the foregoing ones on page 2 of the Advisory Action dated December 18, 2006. As indicated above, the Examiner's position is that LaJoie's ability to alert users of overlapping timers and/or when they try to record an unpurchased IPPV (impulse pay-per-view) program teaches or suggests the desirability of giving a user an opportunity to cancel the purchase of a program in response to the user canceling a scheduled recording of the program, as defined by claims 17, 20 and 24.

In response, Appellants again note that the Examiner is applying the wrong legal standard for obviousness under 35 U.S.C. §103(a). As previously indicated above, the mere fact that a prior art device could (in hindsight) be modified to produce a claimed invention is not a basis for an obviousness rejection unless the prior art suggests the desirability of such a modification. LaJoie fails to teach or suggest such desirability. In particular, the ability to alert users of overlapping timers and/or when they try to record an unpurchased IPPV program, as taught by LaJoie, is a completely different function than giving a user an opportunity to cancel the purchase of a program in response to the user canceling a scheduled recording of the program, as defined by claims 17, 20 and 24. As such, the functionality of LaJoie can in no way be considered to teach or suggest the desirability of the functionality defined by independent claims 17, 20 and 24.

Moreover, the Examiner's reference to the "conflict checking feature" of LaJoie is misplaced with respect to independent claims 17, 20 and 24 since the method defined by these claims would not necessarily create a conflict. In particular, with the claimed invention, a user may cancel the scheduled recording of a purchased program, but still want to purchase the program. As such, there is no inherent conflict when a user cancels the scheduled recording of a purchased program. This is in stark contrast to the inherent conflict that arises with LaJoie when a user sets a timer that overlaps an

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existing timer, or attempts to record an unpurchased IPPV program. Accordingly, for the foregoing reasons, Appellants respectfully request that the Board reverse the rejection of claims 17, 20 and 24.

B. Patentability of Claims 19, 21, 23 and 25

The rejection of claims 19, 21, 23 and 25 under 35 U.S.C. §103(a) based on the proposed combination of LaJoie and the RCA manual should be reversed since the RCA manual is relied upon only for disclosing a "Buy and Record Option" and is unable to remedy the deficiencies of LaJoie pointed out above in conjunction with claims 16-18, 20, 22 and 24. Accordingly, Appellants respectfully request that the Board reverse the rejection of claims 19, 21, 23 and 25.

VIII. Claims Appendix

16.   A method for processing a plurality of programs, comprising:

receiving a first user input selecting a first program for removal from a first list representing a list of programs scheduled for recording;

receiving a second user input selecting a second program for removal from a second list representing a list of programs purchased;

determining whether said second program also appears on said first list responsive to said second user input; and

removing, automatically, said second program from said first list if said second program appears on said first list.

17.   A method for processing a program, comprising:

removing, in response to a user command, said program from a first list of programs representing programs scheduled for recording;

determining, in response to said user command, whether said program is also a purchased program;

enabling an on screen display including an option to cancel the purchase of said program if it is determined that said program is also a purchased program; and

removing said program from a second list of programs representing purchased programs responsive to user selection of said option.

18. An apparatus for processing a program, comprising:

first means for receiving a first user input selecting a first program for removal from a first list representing a list of programs scheduled for recording, and for receiving a second user input selecting a second program for removal from a second list representing a list of programs purchased; and

second means for determining whether said second program also appears on said first list responsive to said second user input, and for automatically removing said second program from said first list if said second program appears on said first list.

19. The apparatus of claim 18, wherein said second means enables display of an on screen user option indicating that a user can both purchase and record a selected program so that said user does not have to select one of purchase and record user options and then select the other user option to purchase and record said selected program.

20. An apparatus for processing a program, comprising:

first means for receiving a user command;

second means for removing said program from a first list of programs representing programs scheduled for recording responsive to said user command;

said second means determining whether said program is also a purchased program responsive to said user command, and enabling an on screen display including an option to cancel the purchase of said program if it is determined that said program is also a purchased program; and

wherein said program is removed from a second list of programs representing purchased programs responsive to user selection of said option.

21. The apparatus of claim 20, wherein said second means enables display of an on screen user option indicating that a user can both purchase and record a selected program so that said user does not have to select one of purchase and record user options and then select the other user option to purchase and record said selected program.

22. An apparatus for processing a program, comprising:

a receiver operative to receive a first user input selecting a first program for removal from a first list representing a list of programs scheduled for recording, and to receive a second user input selecting a second program for removal from a second list representing a list of programs purchased; and

a processor operative to determine whether said second program also appears on said first list responsive to said second user input, and to automatically remove said second program from said first list if said second program appears on said first list.

23. The apparatus of claim 22, wherein said processor enables display of an on screen user option indicating that a user can both purchase and record a selected program so that said user does not have to select one of purchase and record user options and then select the other user option to purchase and record said selected program.

24. An apparatus for processing a program, comprising:

a receiver operative to receive a user command;

a processor operative to remove said program from a first list of programs representing programs scheduled for recording responsive to said user command;

said processor being further operative to determine whether said program is also a purchased program responsive to said user command, and to enable an on screen display including an option to cancel the purchase of said program if it is determined that said program is also a purchased program; and

wherein said program is removed from a second list of programs representing purchased programs responsive to user selection of said option.

25. The apparatus of claim 24, wherein said processor enables display of an on screen user option indicating that a user can both purchase and record a selected program so that said user does not have to select one of purchase and record user options and then select the other user option to purchase and record said selected program.
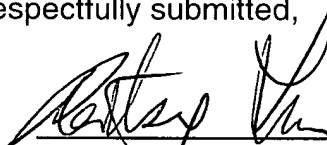
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IX. Evidence Appendix

None.

X. Related Proceedings Appendix

None.

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